

REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on November 12, 2010, and the references cited therewith. At the time of the Office Action, claims 1-7, 9-16 and 18-22 were presented for examination. Claims 1, 10 and 19 are of independent form.

With this Amendment, claims 1, 10 and 19 have been amended. Support for the amended claims may be found in the originally filed application. Accordingly, Applicant believes no new matter has been added to the application.

Reconsideration and allowance of the subject application are requested for at least the following reasons.

35 USC §112 Rejection of the Claims

Claims 1-3 were rejected under 35 USC §112, first paragraph, as failing to comply with the written description requirement. The Office Action sets forth that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

More particularly, the Office Action sets forth that the specification as originally filed has failed to provide support for the recitation of "...defining, using a first computer system, an object on a digital page image...related response to be performed by a second computer system...", and does not reasonably convey to one of skill in the art how to make or use applicant claimed invention for "...defining, using a first computer system, an object on a digital page image...related response to be performed by a second computer system...". Applicant respectfully disagrees with the Office Action for at least for the following reasons.

As set forth in the specification, "[o]nce the position information is received by the *user's computer system 102*, the information may be processed by an application program called a "player" component herein." (See paragraph [0027] of U.S. Publication No. 2007/0040809, first sentence; italics emphasis added). Thus, in certain embodiments, computer-system 102 may be understood to be a *user's computer system*.

Now, with the above in mind, the next paragraph of the specification recites, in part, as follows:

“[0028] Prior to use, at least one database must be generated to contain action/response information relating the pen tip position, current book contents, current page of the book, multimedia contents for the current book, and pre-defined actions for the current book. An application program executing on a *publisher's computer system* called a “maker” component herein may be used to create the linkages between these data items. The maker may be used by a publisher (or in some cases by a sophisticated user) to make an interactive multimedia product based on an existing traditional paper book (or possibly a newly published book), with limited manual work.” (Paragraph [0028] of U.S. Publication No. 2007/0040809; italics emphasis added).

Thus, in light of the foregoing, Applicant's specification clearly sets forth that the application program called a “player” may be used with a *user's computer system*, and the application program called a “maker” may be used with a *publisher's computer system*. In certain embodiments, the publisher's computer system may be understood to execute the maker component 300 (shown in FIG. 3), while the user's computer system 102 may be understood to execute the player component 302 (shown in FIG. 3).

Moreover, in the very next paragraph, Applicant's specification acknowledges both computer systems, and that, in certain embodiments, the two systems may not be necessary and one computer system may suffice, as follows:

“[0029] In one embodiment, the *publisher's computer system* may be the same as the *user's computer system* for the case where the interactive multimedia product and/or the book are produced by the user or another person at the user's site (e.g., a parent prepares the linkages for use by a child).” (Paragraph [0029] of U.S. Publication No. 2007/0040809; italics emphasis added)

In light of the foregoing, Applicant believes it has been shown that the specification contains a written description of two computer systems as recited by independent claims 1-3, which are described in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Withdrawal of the rejection is respectfully requested upon reconsideration.

Claims 1-3 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

More particularly, the Office Action sets forth that the limitation of Claims 1-3 “...defining, using a first computer system, an object on a digital page image...related response to be performed by a second computer system...” is not clear. The Office Action goes on to ask: What are “a first computer system” and “a second computer system”?, and Which is “...a first computer system...” or “...a second computer system...” disclosed as 102, 106, 108, and 110 in the Specification and Drawings? The Office Action then concludes that there *is only one computer system* disclosed in the Specification and Drawings namely, computer system 102. Applicant respectfully disagrees with the Office Action for at least for the following reasons.

As set forth above, a first computer system may be understood, in certain embodiments, to include a publisher’s computer system, and the second computer system may be understood, in certain embodiments, to include a user’s computer system. Furthermore, in certain embodiments, the publisher’s computer system may be understood to execute the maker component **300** (shown in FIG. 3), while the user’s computer system may be understood to execute the player component **302** (shown in FIG. 3).

Withdrawal of the rejection is respectfully requested upon reconsideration.

35 USC §102 Rejection of the Claims

Claims 1-5, 9-14, 18-19 and 21-22 were rejected under 35 U.S.C. §102(b) as being anticipated by LeKuch et al., U.S. Publication No. 2002/0041271 A1 (hereinafter “LeKuch”).

The Applicant appreciates the Examiner’s thorough application of the cited art to the claims. After careful review of the art, the Applicant respectfully disagrees with the rejection, and believes that LeKuch does not anticipate the claims under 35 U.S.C. § 102(b). Applicant will now explain.

Rejections under 35 U.S.C. §102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. See In re Arkley, 455 F.2d 586, 587 (CCPA 1972). It is not enough that the prior art reference discloses part of the claimed invention, which an ordinary artisan might supplement to make the whole, or that it includes multiple, distinct teachings that the artisan might somehow combine to achieve the claimed invention. See Arkley, 455 F.2d at 587. Furthermore, unless a reference discloses within the four corners of the document not only all the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. §102. See Net MoneyIN, Inc. v. VeriSign, Inc., 545 F.3d 1359, 1369 (Fed. Cir. 2008).

Turning to the claims, in the amendment filed October 14, 2010, the Applicant amended independent claim 1 to recite, *inter alia*, “linking, using the first computer system, a position of the object on the digital page image to a related response to be performed by a second computer system...wherein the related response to be performed by the second computer system is configured to provide multimedia content to the user while reading the book.”

From the foregoing, the Applicant understands claim 1 to require linking, using the first computer system, a position of the object on the digital page image to a related response to be performed by a second computer system. Stated another way, the position of the object on the digital page image may be understood to operate as a precursor to determine the related response to be performed by the second computer.

Now, turning to the Office Action, the following characterization of LeKuch is provided in raising the rejection:

“linking, using the first computer system ([0019], FIG. 1, i.e. digitizer grid 30), a position of the object on the digital page image ([0032], FIG. 2, i.e. unique identifier can be a predetermined location) to a related response to be performed ([0032], FIG. 2, i.e. particular sequence of operation) by a second computer system ([0022], ([0023], FIG. 2, i.e. PC 200)...”. Page 4 of the Office Action.

However, the Applicant does not believe the foregoing to be an accurate characterization of LeKuch. For reference, the relevant portion of paragraph [0032] of LeKuch recites as follows:

“The user may also specify the location for the unique identifier by performing a particular sequence of operations with the input pen device 40, such as, double-tapping paper pad 80 with input pen 40.” (Paragraph [0032] of LeKuch, last sentence)

Applicant believes that performing a particular sequence of operations with the input pen device as recited by LeKuch may not provide the claimed feature of “a related response to be performed by a second computer system.” The Applicant will now explain.

From review of LeKuch, “performing a particular sequence of operations with the input pen device 40, such as, double-tapping paper pad 80 with input pen 40” is understood to be performed a precursor to specify the location for the unique identifier. However, as set forth above, Applicant understands claim 1 to require linking, using the first computer system, a position of the object on the digital page image to a related response to be performed by a second computer system. In other words, specifying the location for the unique identifier in LeKuch appears to be a response to performing the particular sequence of operations with the input pen device, and not vice-versa as appears to be set forth in the Office Action.

As set forth above, unless a reference discloses all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. §102. Applicant believes that, in light of the foregoing showing that LeKuch does not disclose all of the limitations arranged or combined in the same way as recited in the claim, LeKuch cannot be said to anticipate independent claim 1 under 35 U.S.C. §102, or independent claims 10 and 19 by similar reasoning. Withdrawal of the rejection is respectfully requested upon reconsideration.

35 USC §103 Rejection of the Claims

Claims 6-7, 15-16 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over LeKuch et al. (U.S. Publication No. 2002/0041271 A1).

The deficiencies of LeKuch with respect to claims 1, 10 and 19 have been described above. Without conceding that “it is obviously well-known that a mouse may replace pen 40 as an input device: in the system of LeKuch, Applicants respectfully submit that claims 6, 7, 15 and 16 are patentable over LeKuch by virtue of their dependencies from claim 1 or 10 and the provided reasoning. Applicants further submit that claim 20 is patentable over LeKuch by virtue of its dependency from claim 19 and the provided reasoning. Withdrawal of the rejection is respectfully requested upon reconsideration.

Claim Amendments

In order to further distinguish from LeKuch, Applicant has amended claim 1 to recite that the related response to be performed by the second computer system comprises rendering multimedia content to be provided to the user while reading the book and linked to the position of the object, and wherein the multimedia content is different from the object on the digital on the digital page image.

In further review of the rejection, it is set forth in the Office Action that LeKuch provides multimedia content as follows:

“wherein the related response to be performed by the second computer system (*{0023}*), *FIG. 2, i.e. PC 200*) is configured to provide multimedia content to the user while reading the book (*{0018}*), *FIG. 2, i.e. inherently well-known as multi-tasking, e.g. playing music (CD-ROM players) while reading other applications on screen*).” Page 5 of the Office Action.

From the foregoing passage of the Office Action, it appears that the Office Action fails to appreciate that claim 1 requires *linking*, using the first computer system, a position of the object on the digital page image to a related response to be performed by a second computer system. The Office Action merely sets forth that it is inherently well-known to play music while reading other applications on screen, but has failed to show how such are linked as required by claim 1.

In light of the foregoing, Applicant has amended claim 1 to recite that the related response to be performed by the second computer system comprises multimedia content to be provided to the user while reading the book and linked to the position of the object. Applicant believes such makes clearer that the related response to be performed by a second computer system is linked to the position of the object.

Applicant has also amended claim 1 to recite that the multimedia content is different from the object.

As the Applicant understands LeKuch, LeKuch merely provides that writings and drawings made on paper pad 80 can be conveyed by input pen 40, processed by CPU 60, and stored in memory 70 as an electronic (i.e., virtual) representation of writings and drawings created by the user on paper pad 80. LeKuch, paragraph [0024]. Thus, the electronic (i.e., virtual) representation of writings/drawings may be understood to be merely the same as the physical writings/drawings, albeit in electronic form. Furthermore, it appears that LeKuch desires to keep both the electronic and physical writings/drawings the same, particularly as the Applicant understands LeKuch to merely aim to overcome the difficulty of associating pages of a physical writing with pages of an electronic representation of the physical writings. LeKuch, paragraph [0008]. Quite simply, there appears to be no suggestion from LeKuch that the electronic representation should be anything but the same as physical writings/drawings.

Thus, even if it could be shown that the electronic representation of writings and drawings of LeKuch may be considered as multimedia content, the electronic representation of writings and drawings of LeKuch may not be expected to be different that the object (i.e. the physical writings and drawings). Consequently, Applicant believes LeKuch does not teach or suggest the multimedia content being different from the object.

Applicant provides multimedia content which is different from the object to provide information to the user which may be related to the object, which may enhance learning or entertainment, which is quite different from LeKuch.

Accordingly, Applicant believes that it has been demonstrated that independent claim 1 distinguishes over the teachings of the cited art. To expedite prosecution, Applicant has

amended independent claims 10 and 19 similar to claim 1, and believes independent claims 10 and 19 to be allowable for similar reasoning as set forth above with respect to independent claim 1.

In view of the foregoing remarks, it is respectfully submitted that independent claims 1, 10 and 19 are patentable over the art, and the conditions of patentability have been satisfied. Withdrawal of the rejection upon reconsideration and allowance of independent claims 1, 10 and 19, as well as the claims which depend directly or ultimately therefrom, is respectfully requested.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (603-668-6560) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-4238.

Respectfully submitted,

MINERVA M. YEUNG ET AL.

By their Representatives,

CUSTOMER NUMBER: 45459

Telephone Number: 603-668-6560

By /Edmund P. Pfleger/
Edmund P. Pfleger
Reg. No. 41,252